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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,672

11/28/2001

Peter S. Weissman

8288

7590

07/27/2006

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EXAMINER

TRAN, NGHI V

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,672	WEISSMAN, PETER S.	
	Examiner	Art Unit	
	Nghi V. Tran	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-13 AND 19 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 14-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6-11, 14-18, and 20 are rejected under 35 U.S.C. 101 because of the following reasons:

3. Claim 1 and 14 are directly not limited to "functional descriptive material" because claims 1 and 14 are directly and/or indirectly to a computer program and/or a computer software application. According to "Patent Eligibility Guidelines 35 USC 101", pages 50-51, and according to MPEP 2106 page 2100-2012, a computer program is directed to non-statutory subject matter. For example, the Interim Guidelines recites "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory..." On the other hand, the claims 1 and 14 recite "A computer program having instructions, the computer program comprising: first email...with the first email." and "A computer software application having instructions that when executed by a processor, cause the processor to execute the steps comprising the steps of: processing a primary email...with the processing of the primary email." (emphasis added) are directed to non-statutory subject matter because claims 1 and 14 are just limited to computer program

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and computer application per se, instead being defined as including structurally and functionally interrelated to the medium. Further, claims 1 and 14 lack structurally and functionally to recorded on some computer-readable medium. Therefore, claims 1 and 14 are directed to non-statutory subject matter because they are not directly to "functional descriptive material".

4. Claims 2-4, 6-11, 15-18, and 20 are also rejected under 35 U.S.C. 101 because they are directly on independent claims 1 and 14.

Response to Arguments

5. Applicant's arguments filed December 30, 2005 have been fully considered but they are not persuasive because of the following: claim 1 and 14 are directly not limited to "functional descriptive material" because claims 1 and 14 are directly and/or indirectly to a computer program and/or a computer software application. According to "Patent Eligibility Guidelines 35 USC 101", pages 50-51, and according to MPEP 2106 page 2100-2012, a computer program is directed to non-statutory subject matter. For example, the Interim Guidelines recites "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory..." On the other hand, the claims 1 and 14 recite "A computer program having instructions, the computer program comprising: first email...with the first email." and "A computer software application having instructions that when executed by a processor, cause the processor to execute the

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steps comprising the steps of: processing a primary email...with the processing of the primary email.” (emphasis added) are directed to non-statutory subject matter because claims 1 and 14 are just limited to computer program and computer application per se, instead being defined as including structurally and functionally interrelated to the medium. Further, claims 1 and 14 lack structurally and functionally to recorded on some computer-readable medium. Therefore, claims 1 and 14 are directed to non-statutory subject matter because they are not directly to “functional descriptive material”.

Allowable Subject Matter

6. Claims 12-13 and 19 are allowed.

7. This communication warrants no examiner's reason for allowance, as applicant's reply makes evident the reason for allowance, satisfying the record as whole as required by rule 37 CFR 1.104 (e). In this case, the substance of applicant's remarks filed on September 28, 2005 with respect to the amended claim limitations point out the reason claims are patentable over the prior art of record. Thus, the reason for allowance is in all probability evident from the record and no statement for examiner's reason for allowance is necessary (see MPEP 13202.14).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh Dinh
Primary Examiner